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CENTRAL FAX CENTER****FEB 08 2007****PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re application of:  
Benjamin et al.

Serial No.: 10/827,139

Filed: 4/19/04

For: **FLUID EJECTION DEVICE**Date of Restriction Requirement:  
January 10, 2007

Examiner: Laura E. Martin

Art Unit: 2853

Attorney Docket No.:  
200209168-1

February 8, 2007

**PETITION TO DIRECTOR UNDER 37 CFR §1.181 and  
PETITION FROM REQUIREMENT FOR RESTRICTION (37 CFR §1.144)**Mail Stop Petitions  
Commissioner for Patents  
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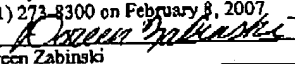
Dear Sir:

Applicant petitions the Director to review and withdrawn the Restriction Requirement of January 10, 2007 issued in the present application.

**CERTIFICATE OF FACSIMILE**

Date of Deposit: February 8, 2007

I hereby certify that these papers are being transmitted to The Patent and Trademark Office facsimile number (571) 273-8300 on February 8, 2007.

  
Dorcen Zabinski

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**Remarks**

This Petition is in response to the Restriction Requirement of January 10, 2007. The Restriction was issued to replace a prior restriction issued October 2, 2006, which was an improper restriction and withdrawn by the Examiner. Applicant has requested reexamination and reconsideration, and has traversed both restrictions. Thus, the petition should be considered under 37 CFR 1.144 and 37 CFR 1.181.

Applicant respectfully submits that the restriction fails to establish a prima facie case for the propriety of the restriction requirement. In fact, the restriction fails to provide any rationale to support its conclusion. MPEP 808.01 requires that the Examiner provide particular reasons for holding that the inventions as claimed are either independent or distinct and that those reasons should be concisely stated. The restriction fails to comply with MPEP 808.01 and thus the restriction cannot stand.

Additionally, the Director should be aware that a first Office Action was issued on 4-20-2006. That Action involved a full and extensive prior art search for all pending claims and a full substantive examination on the merits was provided. Yet the only conclusion of the present restriction states that the alleged species "requires a different and extensive search." (Office Action, page 3, lines 6-7). No new claims were added to the application in Applicant's response filed 7-19-2006 that would warrant a different search. Therefore, the conclusion that a different and extensive search is required is not supported by the Examiner's previously conducted search, is not supported by any authority, and is baseless.

Therefore, the restriction is unwarranted and should be withdrawn. A more detailed explanation of the restriction and Applicant's supporting rationale is provided as follows.

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**Summary of The Restriction**

The Restriction of Jan. 10, 2007 stated that restriction to one of the following species was required under 35 U.S.C. 121, as described in the Office Action:

**Species I:** hereby drawn to a first fire line, a second fire line, a first address generator, a second address generator, a first drop generator, and a second drop generator;

**Species II:** hereby drawn to a first fire line, a second fire line, a first address generator, a second address generator, and fluid ejectors;

**Species III:** hereby drawn to a first address generator, a second address generator, first resistors, second resistors, a first address line, a second address line, the first resistors being located in a first section and the second resistors being located in a second section of the fluid ejection device;

**Species IV:** hereby drawn to a first fire line, a first address generator, a second address generator, a first drop generator, a second drop generator, data lines, and a first fluid feed source;

**Species V:** hereby drawn to a first fire line, a first address generator, a first drop generator, a second drop generator, data lines, and a fluid feed source;

**Species VI:** hereby drawn to a first fire line, a first address generator, a first drop generator, and a latch.

Claims 35, 36 and 38 were indicated to be generic to species I and species III.

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**Election**

Applicant filed an election, with traverse, electing Species I. A listing of claims readable on Species I are claims 1-36 and 38-42. The election was filed concurrently with the present Petition.

The restriction is improper for the following reasons:

MPEP 809.02(a) "Election of Species Required" cites MPEP § 808.01(a) for determining when a restriction between species is appropriate. MPEP 808.01 states:

**MPEP 808.01 Reasons for Holding of Independence or Distinctness**

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. [Emphasis added]

For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed. (MPEP 808.01)

The Office Action articulates only a mere conclusion for requiring an election of a single species as:

"The species are independent or distinct because each species requires a different and extensive search." (Office Action, page 3, lines 6-7)

No other reasoning was provided. Applicant respectfully submits that the statement of "requires a different and extensive search" is a mere conclusion and is not a valid reason under MPEP 808.01 that supports a restriction requirement. The conclusion also does not prove that the identified species are independent and distinct. For proving distinct claims in a restriction, MPEP 806.05(e) states, "The burden is on the examiner to provide reasonable examples that recite material differences." In the present restriction, no examples have been provided and no material differences have been recited. Therefore, a prima facie case for the propriety of the restriction requirement has not been presented. The restriction is thus improper and should be withdrawn.

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Full Search Already Performed

Applicant respectfully notes that the first Office Action dated 4-20-2006 included a full and extensive prior art search for all pending claims. Furthermore, a substantive examination on the merits was provided. In Applicant's response, no new claims were added. Therefore, if a "different and extensive search" was not needed then, how can this be a reason for restriction at this time for the same claims? The fact that the Examiner already performed a search contradicts and disproves the Examiner's own conclusion. Furthermore, with today's network technology of easily searchable databases, broad and extensive searches can be performed in short periods of time. Thus, the Examiner's conclusion is not supported, the restriction is not justified, and should be withdrawn. Applicant notes that in the time spent preparing and issuing the previous two (2) restrictions and responding to the previous election with traversal, a new search could have been performed.

Restriction Is Not Proper Since Species Are Not Mutually Exclusive MPEP 806.04(f)

As an additional reason for traversal, a comparison of the limitations and scope of each independent claim shows that the claims share many of the same limitations. Thus, the independent claims overlap in scope and therefore, the species are not mutually exclusive. Accordingly, restriction between claims limited to species should not be required based on MPEP 806.04(f), which states:

MPEP 806.04(f) Restriction Between Mutually Exclusive Species

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope. [Emphasis Added]

In the present application, the identified species are not mutually exclusive and the claims overlap in scope since they recite similar limitations disclosed for the multiple species. Therefore in view of MPEP 806.04(f), the restriction is improper and should be withdrawn.

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**Conclusion**

For the reasons set forth above, the restriction is unwarranted and should be withdrawn. Applicant respectfully requests that the Director withdraw the restriction and prohibit further restrictions that are merely delaying the examination of the application. It has been nearly one year since the first office action on the merits. Accordingly, an early examination on the merits of the application for all claims and a response to Applicant's response filed July 19, 2006 is earnestly solicited.

Respectfully submitted,



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